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10/671,419	09/26/2005	Koichi Yokota	Q77459	83V3

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EXAMINER

SCHILLING, RICHARD L.

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671410

Applicant(s)

Yokota et al

Examiner

R L Schilling

Group Art Unit

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—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(c).

Status

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-10 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some ☐ None of the:
 - ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received
- In this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 2-19-04
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-848
- ☐ Other _____

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1. Claims 1-10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. There are periods in the middle of claims 1-3.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) The invention was described in (1) an application for patent, published under Section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ikeda et al. The applied reference has a common assignee and inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. Ikeda et al. (see particularly paragraphs 6-15, 19; Example 1) discloses color photographic materials containing protective layers with UV absorbing agents and surfactants within the scope of Formula A of the instant claims. Ikeda et al. does not disclose the relative

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sensitivities of the photographic elements to blue and UV exposure or the sensitivity ratio required by the instant claims.

However, the color photographic elements of Example 1 in Ikeda et al. inherently meet the sensitivity ratios of the instant claims. Example 1 in applicants' specification alters the sensitivity ratios by altering the amount of UV absorbing agents in the protective layers to lower the sensitivity to UV light of the photographic films. The total amount of UV absorbing agent in the protective layers in Example 1 of applicants' specification is $.468 \text{ g/m}^2$ while in Example 1 of Ikeda et al. the protective layer contains UV absorbers at $.567 \text{ g/m}^2$, i.e. about 20% more UV absorbing agent. Also, Example 1 in Ikeda et al. contains about $.3 \text{ g/m}^2$ of UV absorbing silver halide while Example 1 in applicants' specification contains about $.28 \text{ g/m}^2$ of UV absorbing silver halide. The UV absorbing protective layers of Example 1 in applicants' specification and Example 1 in Ikeda et al. contain the same ingredients at the same coverages except for the UV absorbing compounds. Since the protective layers in Ikeda et al. contain substantially more UV absorbing compounds, the photographic elements of Example 1 in Ikeda et al. would have lower sensitivities to UV light, i.e. 370 nm, than Example 1 in applicants' specification. The ratio of sensitivity of 420 nm to 370 nm in Example 1 in applicants' specification is lowered by

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increasing the amount of UV absorbing agents. Since Example 1 in Ikeda et al. has substantially more UV absorbing agents than Example 1 in applicants' specification, the sensitivity ratio in Example 1 of Ikeda et al. would be substantially less than 75% reported for Example 1 in applicants' specification.

3. Claims 1-4 and 8-10 are rejected under 35 U.S.C. § 102(e) as being anticipated by Yamanouchi et al. The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. § 102(e). This rejection under 35 U.S.C. § 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. Yamanouchi et al. (see particularly column 2, lines 30-57; column 8, lines 25-50; Examples 1 and 2) disclose color photographic elements comprising protective layers containing UV absorbing agents and surfactants within the scope of Formula B of the instant claims. Example 2 in Yamanouchi et al. sets forth a color photographic element comprising protective layers containing UV absorbing agents at $.567 \text{ g/m}^2$ and UV absorbing silver halide at $.3 \text{ g/m}^2$. Example 1 in applicants' specification

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sets forth similar color photographic elements containing protective layers the same as Example 2 in Yamanouchi et al. except for the UV absorbing agents and amounts used. The total amount of UV absorbers in Example 1 of applicants' specification is .468 such that Yamanouchi et al. has protective layers with about 20% more UV absorbing agents and substantially more UV absorbing silver halide. Since sensitivity ratios between 420 nm and 370 nm are lowered by increasing UV absorbing agent coverage in Example 1 of applicants' specification and Sample 1 of Example 1 of applicants' specification has a ratio of 75%, the color photographic elements of Example 2 in Yamanouchi et al. with substantially more UV absorbing agents in the protective layer would have sensitivity ratios substantially less than 75% including less than 70% required by the instant claims.

4. Claims 1-4 and 8-10 are rejected under 35 U.S.C. § 102(a) as being anticipated by Yamanouchi et al. Yamanouchi et al. in Example 2 sets forth color photographic elements containing surfactants within the scope of Formula B of the instant claims and UV absorbing compounds such that the sensitivity ratios of the instant claims are obtained in Example 2 of Yamanouchi et al. for the reasons as set forth in paragraph 3 above.

5. Claims 1-4 and 8-10 are rejected under 35 U.S.C. §

102(b) as being anticipated by Japanese Publication 2002-255921.

Japanese Publication 2002-255921 is a publication resulting from the foreign priority document of U.S. Patent 6,589,723 to Yamanouchi et al. The U.S. patent to Yamanouchi et al. is considered to be an English language translation of the Japanese publication which is available as prior art under 35 U.S.C. § 102, paragraph b. The Japanese publication anticipates the instant claims for the same reasons as set forth in paragraph 3 above as to why the U.S. patent to Yamanouchi et al. anticipates the instant claims. Since Yamanouchi et al. has a common assignee with the instant application, the assignee is requested to state whether or not the U.S. patent to Yamanouchi et al. is in fact essentially an English translation of the Japanese publication to Yamanouchi et al.

6. Kanazawa et al. is cited of interest in the art as disclosing color photographic films containing surfactants as set forth in the instant claims. Tamaoki is cited of interest in the art as disclosing roll films which may contain surfactants. Furlin et al., Yamada et al., Takeuchi et al. '308 and Pitt et al. are cited of interest in the art as disclosing photographic elements containing surfactants as set forth in the instant claims. The prior art submitted by applicants also has been considered.

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7. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

May 26, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP 1400

